

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

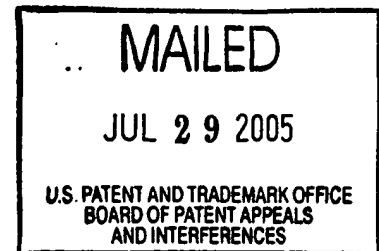
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLIFFORD A. PICKOVER, PAUL A. MOSKOWITZ,
STEPHAN J. BOIES and WILLIAM GREY

Appeal No. 2005-1358
Application No. 09/785,572

ON BRIEF



Before BARRETT, DIXON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-6, 9, 10, 14-26, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method of supporting a software program. Claim 1 is representative of the invention, and is reproduced as follows:

1. A method of supporting a software program, comprising:
receiving error data for at least a first error, said at least first error, said at least first error including a user

error performed by a user in operating the software program;
identifying a patch for said at least first error; and
forwarding said patch to update said software program.

The prior art references of record relied upon by the
examiner in rejecting the appealed claims are:

Cheng et al. (Cheng)	6,151,643	Nov. 21, 2000
Othmer et al. (Othmer)	6,167,358	Dec. 26, 2000
Cohen	6,553,507	Apr. 22, 2003 (filed Sep. 30, 1998)

Claims 1-5, 9, 10, 20-23, 25 and 26 stand rejected under 35
U.S.C. § 103(a) as being unpatentable over Cohen in view of
Othmer.

Claims 6, 14-19¹ and 24 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Cohen in view of Othmer, and
further in view of Cheng.

Rather than reiterate the conflicting viewpoints advanced by
the examiner and appellants regarding the above-noted rejections,
we make reference to the examiner's answer (mailed August 2,
2004) for the examiner's complete reasoning in support of the
rejections, and to appellants' brief (Supp. brief, filed May 17,
2004) and reply brief (filed September 13, 2004) for appellants'

¹ It is unclear why appellants grouped claims 14-19 with claim 1 even though the basis for their rejection is consistent with claims 6 and 24. Accordingly we presume claims 14-19 are properly grouped with claims 6 and 24.

arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm. We begin with the rejection of claims 1-5, 9, 10, 20-23, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Cohen in view of Othmer.

We note at the outset the statement (brief, page 4) that "[a]ppellants group the pending claims as follows:
Group I - claims 1-5, 9, 10, 14-23, 25 and 26. Group
II - claims 6 and 24." Consistent with this statement,

appellants arguments with respect to Group I are directed to claim 1, and appellants' arguments with respect to Group II are generic to both claims 6 and 24. Accordingly, we select claims 1 and 6 as representative of the two groups. We turn first to claim 1. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 3 and 4) is that "Cohen discloses a method of supporting a software program, comprising: receiving error data for at least a first error; identifying a patch for said at least first error; and forwarding said patch to update said software program." The examiner acknowledges (answer, page 4) that Cohen does not "explicitly disclose said at least first error including a user error performed by a user in operating the software program." To overcome this deficiency of Cohen, the examiner (id.) turns to Othmer for a teaching of "a method of receiving error data for at least a first error, said at least first error including a user error performed by a user in operating the software program." The examiner argues that "[a] person of ordinary skill in the art would have been motivated to make such a combination because

Cohen discloses identifying errors and forwarding a patch to provide a solution, and user error performed by a user in operating the software program is a known type of error that requires a solution, as per teaching of Othmer."

Appellants' position (brief, page 5) is that Cohen makes no mention whatsoever of user errors. Appellant argues (brief, page 5) that Othmer "is primarily concerned with details of how information can be gathered at the remote computers and transmitted to and managed by the server." Appellants further assert (brief, page 5 and reply brief, page 2) that Othmer discusses user error "only in the context of reporting to an information system manager problems involved in operation of a company's internal network". It is also the appellants' position (id.) that Othmer fails to "teach or suggest identifying a patch for the user error or forwarding such a patch as an update" as the examiner asserts.

We begin with claim construction. Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the

language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim 6 to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claim, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them

differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible inputting of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988).

What we are dealing with in this case is the construction of the limitations recited in the appealed claims. As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in

the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that the claim language does not recite that the method is implemented by a computer. In addition, although appellants' specification states (page 2) that "[i]t would be desirable to provide a system and method which allows automatic correction and support of software where the user is not required to take actions to contact a manufacturer for an update or patch," we find that claim 1 does not recite that the supporting a software program includes automatic correction. In addition, we find that the language "receiving error data" does not recite how the data is received, or who receives it. Nor does the claim recite how the "identifying" takes place, nor does the claim recite who does the identifying. In addition, the claim does not recite how or in what manner the patch is forwarded. Moreover, with regard to the claimed "patch," we find from the specification (page 5) discloses that

[a]s used herein, the term 'patch' is used to refer to code used to update, fix, or otherwise modify a software program and includes general-purpose fixes that replace or alter portions of a program. "Patch", as used herein, also refers to code, instructions, or other information provided to a user of a user device to facilitate correction of a user error. Further, "patch" may also include data or other information used to correct a media error such as a defect on a CDROM."

From the definition of a "patch" as described in appellants' specification, we find the term to broadly apply to information provided to a user to facilitate correction of a user error. From the database chart found in figure 5, we find, for example patch code(s) M1212. In figure 6, we find that the patch code M1212 refers to a text file that explains to a user that the user is trying to view a file without the proper viewer. The user is advised to read attached instructions for downloading the viewer. From this disclosure, we find that the patch need not update the software program, but rather can provide a text file to the user to provide the user with information as to how to update the software program by adding the viewer. Although it would appear the term patch, as used in claim 1 is indefinite as it relates to a user error, we decline to add a rejection under 35 U.S.C. § 112, second paragraph since the examiner did not see fit to do so. Accordingly, we simply consider the term patch, as recited in claim 1, to be very broad.

In addition, we find from the Background of the Invention in appellants' specification (page 1) that

"software users commonly encounter software errors. Errors can arise from a number of different conditions including, for example, incompatibilities between different software applications, user errors, memory errors, and the like. Often, software manufacturers produce patches or fixes to software upon learning of the error. However, it is quite difficult to disseminate these patches or fixes to thousands or even

millions of geographically diverse users after they have already commenced use of the software. Typically, software manufacturers attempt to notify users of the need to upgrade or receive a patch by publicizing new releases or service packs, which interested users can download and install by, for example, visiting the manufacturer's Website."

From this disclosure, and the portions of the specification discussed, supra, we find that it was known that software errors were known to include user errors, and that software manufacturers would produce patches to software upon learning of the error. The admitted prior art does not say how the manufacturers found out about the software errors. Thus, it is assumed that the software manufacturers either discovered the errors or were notified of the errors. The claim does not recite how the needed patch was identified. As broadly drafted, claim 1 reads on the prior art software manufacturers receiving information regarding user errors, creating or identifying a patch, and allowing users to visit their web sites to identify and download whatever patch or patches were necessary to correct user problems.

In any event, with this broad interpretation of the claim language in mind, we turn to Cohen. Although both the examiner and appellants agree that Cohen is silent with respect to user errors, we note that Cohen discloses fault detector 108 to be configured to detect faults during execution of a software

program. Although Cohen is not specific as to whether the faults are due to user errors or programming errors, the language suggests errors, without being specific. From the disclosure in appellants' specification (page 1) that software errors were known to include user errors, we find a suggestion in the admitted prior art to use Cohen's system for software errors that include user errors.

In addition, from our review of Othmer, we find (col. 6, lines 58-60) that software crashes can be due to user errors, web site errors or bugs. From this disclosure of Othmer, we find a second recognition that software errors can include user errors, and find a suggestion to use the system of Cohen for user errors. In addition, from the disclosure of Othmer (col. 7, lines 34 and 45-50) that upon diagnosing user errors and determining if a system crash occurred as a result of human error, the server could automatically send an e-mail to the user of the client computer, we find that the sending of an e-mail to be no different than sending a text message to the user, as in appellants' disclosure.

We are not persuaded by appellants' assertion (brief, page 6) that these two references, alone or cumulatively, fail to teach or suggest the limitations of claim 1. Nor are we persuaded, for the reasons, supra, by appellants' assertion

(brief, page 8) that "[n]either of Cohen and Othmer taken alone, nor their combination, produces the insight provided in the present application that a user error may be automatically remedied by downloading a patch to the user's computer."

Nor are we persuaded by appellants' assertion (id.) that, "Othmer fails to recognize that user errors may be treated in the same fashion that Cohen treats program errors, and so may be automatically remedied with patches." Notwithstanding appellants' assertion to the contrary, this is exactly what the combination of Cohen, the admitted prior art and Othmer suggest because Cohen establishes a system for identifying and updating software errors while Othmer and the admitted prior art establish that a user error is a type of software error.

From all of the above, we find that the teachings of Cohen and Othmer establish a prima facie case of obviousness of claim 1, which has not been successfully rebutted by appellants. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) is affirmed. As claims 2-5, 9, 10, 14-23, 25 and 26 fall with claim 1 (brief, page 4) the rejection of claims 2-5, 9, 10, 14-23, 25 and 26 under 35 U.S.C. § 103(a) is affirmed.

We turn next to claim 6. The examiner's position (answer, pages 8-10) is that Cheng discloses receiving payment for a patch, wherein said payment is received by a provider of said

software program in exchange for coordinating and linking the end users to the software provider's computer. This indicates notifying a third party of at least a first error and thus meets the limitations of claim 6.

Appellants' position (brief, pages 9 and 10) is that "[t]here is nothing about having a payment system that requires that user error be reported by the software vendor to a third party such as a service provider that acts as an intermediary."

From our review of claim 6, we find that the claim recites "notifying a third party of said at least first error." Although not brought to our attention by appellants or the examiner, we find, sua sponte, that Cohen discloses (col. 3, line 5) that the invention forwards the error parameters to the software vendor. From this disclosure of Cohen, we find that Cohen discloses or suggests notifying a third party (software vendor) of the at least first error (error parameters), which meets the limitation of claim 6.

We are not persuaded by appellants' assertion (brief, pages 9 and 10) that the payment system in Cheng "requires that user error be reported by the software vendor to a third party such as a service provider that acts as an intermediary." As discussed, supra, a software patch is designed to correct a software error, of which there are several different kinds, including a user

error (originally filed specification, page 1). In Cheng, the method for delivering software updates can be structured in such a way that "the cost of the service may be included in the cost of the software update charged by the software vendor, who then pays the service provider for the service of coordinating and linking end users to the software vendor's computer" (see column 9 lines 22-27). In Cheng, the third party, the service provider, must logically be notified of the type of software error encountered by the user in order to ensure the user is provided the proper patch.

From all of the above, we accordingly find the limitation of claim 6 to be met by Cohen, and consider Cheng to be cumulative to the teachings of Cohen and Othmer. We therefore affirm the rejection of claim 6 under 35 U.S.C. § 103(a) over Cohen in view of Othmer and in further view of Cheng. As claims 14-19 and 24 fall with claim 6, the rejection of claims 14-19 and 24 under 35 U.S.C. § 103(a) is affirmed.

The decision of the examiner to reject claims 1-6, 9, 10 and 14-26 under 35 U.S.C. § 103(a) is affirmed.

AFFIRMED

SSL/kis

Appeal No. 2005-1358
Application No. 09/785,572

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